

## **REMARKS**

### **I. Introduction**

Claims 14 to 27 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejections of Claims 14 to 16, 18 to 20, 23, 24, and 27**

Claims 14 to 16, 18 to 20, 23, 24, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,662,255 ("Garrett"). It is respectfully submitted that Garrett does not anticipate the presently pending claims for at least the following reasons.

Claim 14, as presented, relates in relevant part to a hand-held locating device for detecting an object enclosed in a medium, including a housing, at least one sensor system enclosed within an interior of the housing, evaluation electronics enclosed within the interior of the housing in which the sensor system is also enclosed, and a handle attached to the housing, the handle situated in close proximity to the housing so as to permit an operator to grasp the handle while operating the device for marking a surface of the medium, wherein the housing, which encloses the sensor system and the evaluation electronics in the interior, includes an opening penetrating therethrough, the opening configured in size to guide a device for marking a surface of the medium. Support for this amendment may be found, for example, at page 6, lines 19 to 24, and page 8, lines 21 to 25, as well as Fig. 1.

Garrett does not disclose, or even suggest, a housing having an interior in which both at least one sensor system and evaluation electronics are enclosed. The Office Action refers to the conductor assembly 32, 32a, or the translucent casing 50a of Figs. 1 and 9 of Garrett as disclosing a housing having an opening penetrating therethrough. The Office Action then refers to the conductor 45, positioned in the probe assembly 11, as the sensor system positioned in the housing of claim 14. It is clear from Figs. 1 and 9 of Garrett, however, that the conductor assembly 32, 32a, and the translucent casing 50a contain only the conductors 45 and 52, and does not contain any evaluation electronics.

In sum, the present invention provides a compact device containing all of the claimed features. The prior art, including the classic metal detector, does not disclose or suggest all of these features contained on or within the featured housing, and therefore cannot anticipate independent claim 14, or its dependent claims 15, 16, 18 to 20, 23, 24, and 27.

Withdrawal of the present rejection is therefore respectfully requested.

**III. Rejection of Claim 17 Under 35 U.S.C. § 103(a)**

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 4,859,931 ("Yamashita"). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Yamashita does not render unpatentable claim 17.

Claim 17 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Yamashita does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Yamashita does not disclose or suggest all of the features of independent claim 14 or dependent claim 17, and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is therefore respectfully requested

**IV. Rejection of Claims 21 and 22 Under 35 U.S.C. § 103(a)**

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,266,006 ("Audet"). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Audet does not render unpatentable claims 21 and 22.

Claims 21 and 22 depend from claim 14 and therefore incorporate all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Audet does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Audet does not disclose or suggest all of the features of independent claim 14 or dependent claims 21 and 22, and therefore does not render unpatentable the presently pending claims.

Withdrawal of the present rejection is therefore respectfully requested.

**V. Rejection of Claim 25 Under 35 U.S.C. § 103(a)**

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garrett in view of U.S. Patent No. 6,844,713 ("Steber"). For at least the following reasons, Applicants respectfully submit that the combination of Garrett and Steber does not render unpatentable claim 25.

Claim 25 depends from claim 14 and therefore incorporates all of the features of claim 14. For at least the reasons set forth above with respect to claim 14, Garrett does not disclose, or even suggest, all of the features of claim 14. Steber does not cure the critical deficiencies set forth above. As such, the combination of Garrett and Steber does not disclose or suggest all of the features of independent claim 14 or dependent claim 25 and therefore does not render unpatentable the presently pending claim.

Withdrawal of the present rejection is therefore respectfully requested.

**VI. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter included in claim 26.

**VII. New Claim**

New claim 28 has been added herein. It is respectfully submitted that claims 28 adds no new matter and is fully supported by the present application, including the Specification. Claim 28 includes all of the features of claim 14, as presented, and therefore it is respectfully submitted that claim 28 is patentable over the references relied upon for at least the reasons set forth above with respect to claim 14.

Further, new claim 28 includes a display and a control panel positioned on the housing, such elements not disclosed or suggested in the references relied upon. For at least these additional reasons, and those reasons set forth above with respect to claim 14, claim 28 is patentable over the references relied upon.

**VIII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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